

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte KEISUKE KUBOMURA  
and JUNICHI IIZUKA

MAILED

MAR 22 2004

PAT & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Appeal No. 2003-2008  
Application 08/938,706

ON BRIEF

Before JERRY SMITH, BARRY, and SAADAT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-36, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for solving problems that can occur when viewing newly opened windows that are displayed within an enlarged or magnified view. Some of the problems faced in the prior art were that characters in the new window were incompletely displayed, the new window was displayed with a size too large or too small in relation to the old window, or the pre-window view was not in view after the new window was closed.

Representative claim 1 is reproduced as follows:

1. An information processing apparatus for displaying at least a character or an image in a first intended area, defined by a first magnification rate, in an enlarged form at the first designated magnification rate on a screen of a display unit in a second intended area newly opened on the screen, comprising:

detection means for detecting whether a request for opening said second intended area is issued;

determining means for determining a second magnification rate for said second intended area that enlarges said first intended area to said second intended area from a size of a first intended pre-enlarge area as displayed on the screen, and a size assigned to a second intended after-enlarged area to be enlarged on the screen, when said detection means detects that a request is issued for opening said second intended area; and

enlarged display means for displaying said first intended area with said characters or said images in the area on the display screen in an enlarged form within said second intended area in accordance with said second magnification rate determined by said determining means.

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The examiner relies on the following references:

Morgan et al. (Morgan)	5,544,288	Aug. 06, 1996
Warnock et al. (Warnock)	5,634,064	May 27, 1997
Niles et al. (Niles)	5,943,679	Aug. 24, 1999
		(filed Oct. 30, 1996)

Barnes, Kate, 10 Minute Guide to Windows™ 3.1, First Edition, 1992 by Sams, pages 116-117.

Claims 27-34 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the disclosure of Morgan. Claims 1-26, 35 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Warnock in view of Niles. Claim 32 stands additionally rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Morgan in view of Barnes.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the

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examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the prior art evidence relied upon by the examiner fails to support any of the rejections on appeal before us.

Accordingly, we reverse.

We consider first the rejection of claims 27-34 under 35 U.S.C. § 102(a) as anticipated by the disclosure of Morgan.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

These claims stand or fall together as a single group [brief, page 8]. The examiner has indicated how he finds the invention of these claims to be fully met by the disclosure of Morgan [answer, pages 3-5]. With respect to representative, independent claim 27, appellants argue that the examiner has

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failed to address the magnification ratio feature as recited in these claims, and appellants assert that Morgan fails to teach or suggest this claimed feature. The examiner responds that Morgan teaches that a user chooses the magnification ratio of the fonts to be input into a graphical interface [answer, page 19].

Despite the examiner's attempt to read the invention of claim 27 on the disclosure of Morgan, it is not apparent to us how the examiner interpreted the disclosure of Morgan to find anticipation. We have carefully considered the passages of Morgan relied on by the examiner, as well as the rest of the Morgan disclosure, but we are unable to find support for the examiner's findings. In our view, the examiner's findings appear to be based on mere conjecture and opinion. We agree with appellants that the steps of claim 27 which result in the rescaling, resizing, and displaying the window responsive to a user preference, the character size, the magnification ratio, and a display size are not found within the disclosure of Morgan. Therefore, we do not sustain the examiner's rejection of claims 27-34.

We now consider the rejection of claims 1-26, 35 and 36 under 35 U.S.C. § 103(a) based on the teachings of Warnock and Niles. In rejecting claims under 35 U.S.C. § 103, it is

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incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument

and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

The examiner has indicated how he finds the claimed invention to be obvious over the combined teachings of Warnock and Niles [answer, pages 6-15]. With respect to independent claims 1 and 11, appellants argue that the claims require that the enlargement of the newly opened intended area, according to the adjusted or second magnification rate, takes into account both its pre-enlarged size and its size according to a first magnification rate, which is not taught by the prior art. Appellants note that the magnification rate in Niles is determined by the user, which is not based on a first magnification rate. Appellants also argue that there are not first and second magnification rates as claimed [brief, pages 10-

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11]. The examiner responds that Niles discloses the selection and magnification of a document page [answer, page 16].

Appellants respond that Niles teaches using a predetermined size rather than a magnification rate as claimed [reply brief, pages 1-2].

We will not sustain the examiner's rejection of independent claims 1 and 11 for essentially the reasons argued by appellants in the briefs. We have reviewed the portions of Warnock and Niles cited by the examiner, as well as the remainder of these documents, but we are unable to find a suggestion for combining the teachings of Niles with the teachings of Warnock to obtain the second magnification rate in the manner recited in claims 1 and 11. Since we have not sustained the rejection of independent claims 1 and 11, we also do not sustain the rejection of claims 2, 3, 10, 15-17, 35 and 36 which depend therefrom.

With respect to independent claims 4 and 12, appellants argue that the claimed invention requires using the character size in the pre-enlarged new window and a character size at the first magnification rate in determining the second magnification rate. Appellants argue that the examiner has not cited any portion of the prior art as teaching this feature [brief, page 12]. The examiner responds that the features on which appellants

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rely are not recited in the claims [answer, page 17]. Appellants respond that claims 4 and 12 require that the second magnification rate be determined from a size of the character in a first intended pre-enlarged area as displayed on the screen and a size of the character in an area surrounding said first intended area on said display screen [reply brief, page 3].

We will not sustain the examiner's rejection of independent claims 4 and 12 for essentially the reasons argued by appellants in the briefs. We agree with appellants that the combined teachings of Warnock and Niles do not support the determination of a second magnification rate in the manner clearly recited in claims 4 and 12. Since we have not sustained the examiner's rejection of independent claims 4 and 12, we also do not sustain the examiner's rejection of claims 5, 6, 18-20 and 24 which depend therefrom.

With respect to independent claims 7 and 13, appellants argue that the examiner never addressed the determining means determining the second magnification rate from a specified character size as claimed [brief, pages 13-14]. The examiner responds that the features on which appellants rely are not recited in the claims [answer, page 18]. Appellants respond that claims 7 and 13 clearly recite "a specified character size"

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[reply brief, page 3].

We will not sustain the examiner's rejection of independent claims 7 and 13 for essentially the reasons argued by appellants in the briefs. We agree with appellants that the combined teachings of Warnock and Niles do not support the determination of a second magnification rate in the manner clearly recited in claims 7 and 13. Since we have not sustained the examiner's rejection of independent claims 7 and 13, we also do not sustain the examiner's rejection of claims 8, 21, 22 and 25 which depend therefrom.

With respect to independent claims 9 and 14, appellants argue that the claimed invention requires a scrolling prohibition which is not taught by the applied prior art [brief, page 14]. The examiner responds that the prohibited scrolling feature is not taught by Warnock, however, the examiner finds that it would have been obvious to the artisan to supply this feature anyway [answer, pages 18-19]. Appellants respond that the prohibited scrolling feature of claims 9 and 14 cannot occur in Warnock because the page that would be prohibited from scrolling in Warnock is no longer displayed, and therefore, cannot be prohibited from scrolling [reply brief, pages 3-4].

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We will not sustain the examiner's rejection of independent claims 9 and 14 for essentially the reasons argued by appellants in the briefs. We agree with appellants that the combined teachings of Warnock and Niles do not support the prohibition means as recited in claims 9 and 14. Since we have not sustained the examiner's rejection of independent claims 9 and 14, we also do not sustain the examiner's rejection of claims 23 and 26 which depend therefrom.

We now consider the additional rejection of claim 32 based on the teachings of Morgan and Barnes. Claim 32 depends from independent claim 27 which was rejected as anticipated by the disclosure of Morgan. The examiner still relies on Morgan to teach the features of claim 27 which form part of the invention of claim 32. Morgan fails to teach the features of claim 27 for reasons discussed above. Since Morgan does not teach the features of claim 27, and since Barnes does not overcome the deficiencies of Morgan, we do not sustain the examiner's separate rejection of claim 32.

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In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examinee rejecting claims 1-36 is reversed.

REVERSED

*Jerry Smith*

JERRY SMITH )  
Administrative Patent Judge )  
                  )

*Lance Leonard Barry*  
LANCE LEONARD BARRY )  
Administrative Patent Judge )  
                  )

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